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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/265,779	03/10/99	GERS-BARLAG H	BEIERSDORF41

HM12/0316

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EXAMINER	
OWENS JR,H	
ART UNIT	**PAPER NUMBER**
1623	5

DATE MAILED: 03/16/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Notice of Abandonment

Application No.	Applicant(s)
09/265,779	Gers-Barlag
Examiner	**Group Art Unit**
Howard Owens	1623

This application is abandoned in view of:

☒ applicant's failure to timely file a proper response to the Office letter mailed on *Jun 22, 1999* .

☐ A response (with a Certificate of Mailing or Transmission of _____) was received on _____, which is after the expiration of the period for response (including a total extension of time of ____ month(s)) which expired on _____ .

☐ A proposed response was received on _____, but it does not constitute a proper response to the final rejection.

(A proper response to a final rejection consists only of: a timely filed amendment which places the application in condition for allowance; a Notice of Appeal; or the filing of a continuing application under 37 CFR 1.62 (FWC)).

☒ No response has been received.

☐ applicant's failure to timely pay the required issue fee within the statutory period of three months from the mailing date of the Notice of Allowance.

☐ The issue fee (with a Certificate of Mailing or Transmission of _____) was received on _____ .

☐ The submitted issue fee of $_____ is insufficient. The issue fee required by 37 CFR 1.18 is $_____ .

☐ The issue fee has not been received.

☐ applicant's failure to timely file new formal drawings as required in the Notice of Allowability.

☐ Proposed new formal drawings (with a Certificate of Mailing or Transmission of _____) were received on _____ .

☐ The proposed new formal drawings filed _____ are not acceptable.

☐ No proposed new formal drawings have been received.

☐ the express abandonment under 37 CFR 1.62(g) in favor of the FWC application filed on _____ .

☐ the letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.

☐ the letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.

☐ the decision by the Board of Patent Appeals and Interferences rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.

☐ the reason(s) below:

James O. Wilson

GROUP 1600

Detailed Action

Applicant states in the first sentence of the application that this is a divisional of 08/788,147 filed January 24, 1997, now allowed. However, the claims are drawn to a subgenus of the invention allowed in the parent case. Therefore, it appears that this case is a continuation instead of a divisional of the parent. Appropriate correction is required.

Obviousness-Type Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 7 - 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12 - 33 of copending Application No. 08/788,147. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims

are a subgenus of the cosmetic or dermatological claims and the corresponding method of protecting the skin from UV light damage. The selection of a specific emulsifier within the genus claimed in the parent would have been obvious to the person of ordinary skill in the art at the time of the invention for the purpose of obtaining a sunscreen product that would solubilize high levels of the light protective agent.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

103 USC 103 Rejection

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7 - 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP Hei-04/178316 in view of applicant's own admission on page 2, last paragraph, and page 4, last paragraph.

The claims are directed to a cosmetic or dermatological composition comprising a light protective amount of 4,4',4''-(1,3,5-triazine-2,4,6-tryltriimino)- trisbenzoic acid tris (2-ethylhexyl ester) and the emulsifier polyglyceryl 2-polyhydroxystearate. Claim 9 requires that there be at least one additional UVA or UVB filter. Claim 10 requires that there be at least one cosmetically or dermatologically acceptable inorganic pigment. Claim 11 requires the inclusion of at least one cosmetically or dermatologically acceptable auxiliary. Claim 12 requires the presence of at least one antioxidant. Claim 8 is directed to a method for protecting skin from UV light.

The Japanese laid-open specification JP Hei-04/178316 teaches that a genus of the emulsifiers that includes polyglyceryl 2-polyhydroxystearate are cosmetically and dermatologically compatible compounds. This Japanese specification does not disclose either the UV light screening compound nor the specific emulsifier of the instantly claimed compositions. However, the applicant acknowledges that the compound applicant employs as a sunscreen is known in the art as a sunscreen (page 2, last paragraph) and that it is commercially available from BASF Aktiengeselleschaft.

Additionally, the applicant acknowledges that the emulsifier (polyglyceryl 2-polyhydroxystearate) specified in the claims is also a commercially available product (page 4, last paragraph). Therefore, a cosmetic or dermatological composition comprising a known UV light screening agent known in the art and commercially available and an emulsifier also commercially available and taught as cosmetically and dermatologically safe and effective, would have been obvious to the person of ordinary skill in the art wanting an effective sunscreen composition with a high level of UV blocking agent maintained in appropriately in suspension in said composition by an art recognized emulsifier. The motivation to select the instant emulsifier is that it has already been used successfully in previous cosmetic and/or dermatological compositions as taught by JP '316. It would also have been obvious to have added one or more additional UVA or UVB compounds or standard cosmetic pigment, standard antioxidants, or standard auxiliaries to said sunscreen to obtain the art recognized benefits therefrom. The use of the above composition to protect skin from UV light damage would also have been obvious because the active ingredient itself is a sun screening compound. Thus, the instant invention is prima facie obvious in the absence of clear and convincing evidence to the contrary.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kunz, whose telephone number is (703) 308-

4623. The examiner can normally be reached on Tuesday through Friday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marion Knode, can be reached on (703) 308-4311. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Gary L. Kunz

GARY L. KUNZ
PRIMARY EXAMINER
GROUP 1200